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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,481	10/23/2001	Michael L. Zarns	977.045US1	4025

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EXAMINER

MYERS, PAUL R

ART UNIT	PAPER NUMBER
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2112

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,481

Applicant(s)

ZARNS, MICHAEL L.

Examiner

Paul R. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 3: It is unclear as to what the preliminary request is and how it relates to the intercepting step. In accordance with claim 1 the intercepting is of the request not of a preliminary request. The examiner could define the preliminary request of claim 2 as the intercepted request of claim 1 however if that is the case then the request of claim 2 would lack proper antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

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international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Esterson PN 6,633,583.

In regards to claim 1: Esterson teaches a method of remotely interacting with a universal serial bus device (120), comprising: intercepting a request (201) originating on a requesting device (140 Column 2 line 6 to Column 2 line 7), wherein the request seeks access to the universal serial bus device (120); packing the request into an intermediate request (202); transmitting the intermediate request to a servicing device having a universal serial bus controller (203-204); transforming the intermediate request back into the request (205); and passing the request to the controller for processing by the universal serial bus device (206).

In regards to claim 2: Esterson teaches the communication being according to the USB specification, and the wireless communication being bidirectional. In accordance with the USB specification responses from USB devices are required as such Esterson teaches receiving a response to from the USB device; and transmitting the response to the requesting device.

5. Claims 1-4, 6-9, 11-25 are rejected under 35 U.S.C. 102(e) as being anticipated by McAlear PN 6,389,029.

In regards to claims 1, 9, 14, 16, 21, 23: McAlear teaches a method of remotely interacting with a universal serial bus device (100), comprising: intercepting a request (in attachment unit 110) originating on a requesting device (130/140), wherein the request seeks access to the universal serial bus device (100); packing the request into an intermediate request

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(the LAN request on 120); transmitting the intermediate request to a servicing device having a universal serial bus controller (80); transforming the intermediate request back into the request (in end hub 80); and passing the request to the controller for processing by the universal serial bus device (100).

In regards to claims 2, 12-13, 22: McAlear teaches returning a response to the requesting device.

In regards to claim 3: McAlear teaches a preliminary request from device 130 to 140.

In regards to claims 4, 19: McAlear teaches a set of instructions when an enhanced attachment unit (240) is used in place of attachment unit (110).

In regards to claims 6-7, 15, 18, 24-25: McAlear teaches encapsulating the USB request into a LAN protocol such as TCP/IP (Column 24 lines 32-44).

In regards to claim 8: McAlear teaches the channel being a network channel.

In regards to claim 11: McAlear teaches transmitting the request over a USB bus (84).

In regards to claim 20: McAlear teaches a printer as an example of a USB device.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAlear PN 6,389,029.

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In regards to claims 5, 10: McAlear teaches associating memory for the USB devices with the requesting device (Column 49 lines 17-40). McAlear does not expressly teach the format of the storage being a stack. Official notice is taken that a stack is a common form of memory. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use a stack data format because this is an easy data structure to implement.

In regards to claim 17: McAlear teaches communicating the USB request over a network such as a LAN with an internet protocol TCP/IP. McAlear however does not expressly teach the TCP/IP request being sent over the internet. Official notice is taken that transmitting TCP/IP internet protocol packets over the internet is well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to expand the system to include the internet because this would have alleviated any need to build a private network to use remote USB devices.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 703 305 9656. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703 305 4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PAUL R. MYERS
PRIMARY EXAMINER

PRM
May 1, 2004